

The opinion in support of the decision being entered today is *not* binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. EBERT

Appeal 2007-0787
Application 10/689,230
Technology Center 3600

Decided: June 6, 2007

Before RICHARD E. SCHAFER, RICHARD TORCZON, and
ROMULO H. DELMENDO, *Administrative Patent Judges*.

SCHAFER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

- 1 Applicant appeals the Final Rejection of claims 1 to 11 under
- 2 35 U.S.C. § 134 (2002). We have jurisdiction. 35 U.S.C. § 6(b) (2002).
- 3 An examiner rejected Claims 1 and 5 under 35 U.S.C § 102(b) and
- 4 Claims 2-4 and 6-11 under 35 U.S.C. § 103(a). We reverse these rejections
- 5 and enter a new ground of rejection of Claim 1 under § 103(a).

FINDINGS OF FACT

The Claimed Subject Matter

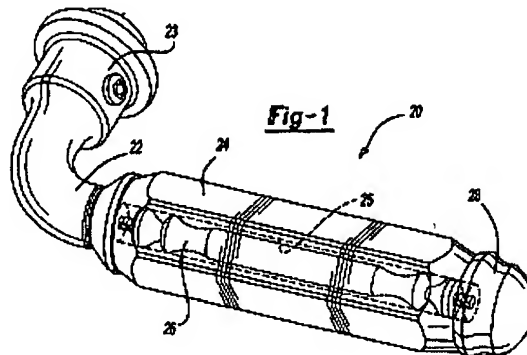
F. 1. Applicant's invention relates to a pivoting or cantilevered lever assembly.

F. 2. Claim 1 provides:¹

1. A lever for a door comprising:
 - a shank to be attached to a door at one end, said shank having an opposed end;
 - a handle attached to said opposed end of said shank, said handle being formed of a material that is more fragile than a material forming said shank.

F. 3. As set out in Claim 1, the lever has but two required parts: a shank and attached handle.

F. 4. Applicant's Figure 1, reproduced below, shows an embodiment of the claimed lever assembly:²



F. 5. The shank is depicted as numeral 22.³

F. 6. The handle is shown as numeral 24.⁴

¹ Appeal Br. 1, Claim 1.

² Specification 2.

³ Specification 2-3.

1 F. 7. The handle must be of “a material that is more fragile than the
2 material forming the shank.”⁵

3 F. 8. The Specification exemplifies the fragile material as glass or crystal,
4 preferably leaded glass crystal.⁶

5 F. 9. The Specification exemplifies the shank as formed of “a metal.”⁷

6 **Prosecution**

7 F. 10. An examiner rejected Claims 1 and 5 under 35 U.S.C § 102(b) as
8 anticipated by a patent to Tokarz.⁸

9 F. 11. The remaining claims have been rejected under 35 U.S.C. § 103(a) as
10 unpatentable over Tokarz or on a combination of Tokarz with other patents.⁹

11 **Tokarz**

12 F. 12. Tokarz describes a lever assembly for a faucet having a structure very
13 similar to the lever claimed by Applicant.

14 F. 13. Tokarz Figure 1, reproduced below, shows an embodiment of
15 Tokarz’s lever assembly.¹⁰

⁴ Specification 3.

⁵ Appeal Br. 9.

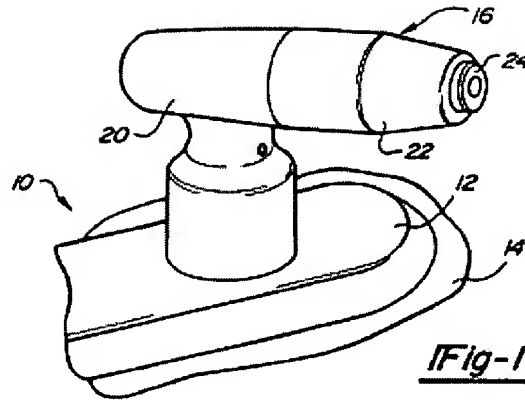
⁶ Specification 1, 2.

⁷ Specification 3.

⁸ U.S. Patent 5,797,422.

⁹ Answer 3-7.

¹⁰ Tokarz 2:10-17.



1 F. 14. The lever assembly includes a shank or base 20 and a lever or handle
2 body 22.¹¹

3 F. 15. The handle 22 may be made of materials including “metal such as
4 chrome or brass, wood, porcelain or plastic.”¹²,

5 F. 16. Tokarz does not describe the material of the shank portion 20.

6 F. 17. Tokarz does not anticipate the subject matter of Claim 1.

7 ISSUES

8 The Examiner contends that the subject matter of Claim 1 is
9 anticipated by the lever assembly described and shown by Tokarz.

10 Applicant contends that Tokarz does not describe all the limitations of
11 Claim 1 and is not anticipated.

12 The issue before us is whether Tokarz describes a lever assembly
13 encompassed by the subject matter of Applicant’s Claim 1.

14 PRINCIPLES OF LAW

15 Anticipation requires that that every limitation of the claim be found,
16 either expressly or under principles of inherency, in a single prior art
17 reference. *Minnesota Mining and Mfg. Co. v. Johnson & Johnson*

¹¹ Tokarz 2:45-47.

¹² Tokarz 1:56-59.

1 *Orthopaedics Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir.
2 1992). Inherency requires that the missing descriptive matter necessarily be
3 present in the thing described in the reference. *In re Robertson*, 169 F.3d
4 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Inherency may not be
5 established by probabilities or possibilities. The mere fact that a certain thing
6 may result from a given set of circumstances is not sufficient. *Continental*
7 *Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749
8 (Fed.Cir. 1991).

9 ANALYSIS

10 Applicant's Claim 1 requires that the handle portion of the lever
11 assembly be made "a material that is more fragile than a material forming
12 said shank."¹³ Tokarz teaches that the handle portion of the lever assembly
13 may be made of "metal such as chrome or brass, wood, porcelain or
14 plastic."¹⁴ Tokarz does not describe the material of the shank portion 20.
15 Thus, Tokarz does not provide a basis for comparing the materials of the
16 handle and shank to determine if Tokarz discloses a handle material that is
17 more fragile than the material forming the shank.

18 The Examiner addresses the "more fragile" limitation by finding that
19 Tokarz teaches a handle portion made of a material including plastic or
20 ceramic and that "one of ordinary skill in the art recognizes that shank
21 portion is likely to be chrome-plated brass for example."¹⁵

22 In order to anticipate, each claim limitation must be expressly or
23 inherently found in the reference. *Minnesota Mining*, 976 F.2d at 1565, 24
24 USPQ2d at 1326. The Tokarz patent neither expressly describes that the

¹³ Appeal Br. Claim 1.

¹⁴ Tokarz 1:56-59.

¹⁵ Answer 3.

1 shank 20 is made of metal nor is it apparent that the Tokarz's shank would
2 inherently be of metal. While it is possible or even probable that one having
3 ordinary skill in the art would understand the shank to be made of metal, that
4 fact is insufficient to establish inherency. The missing disclosure must
5 necessarily flow from the references teachings. *Robertson*, 169 F.3d at 745,
6 49 USPQ2d at 1951. Probabilities and possibilities are insufficient to
7 establish inherency. *Continental Can*, 948 F.2d 1264 at 1269, 20 USPQ2d
8 at 1749. Tokarz does not expressly or inherently describe a shank made of
9 metal. Absent a basis for comparison, Tokarz can not describe a handle
10 made of a material more fragile than the material of the shank.

11 While we view as correct the Examiner's finding that one skilled in
12 the relevant art would recognize that the shank portion of Tokarz handle
13 would likely be a metal such as chrome plated brass, that finding does not
14 establish anticipation. Inferences that the person of ordinary in the art might
15 draw from the express teachings of a reference while relevant to obviousness
16 under § 103(a), do not establish anticipation. The Federal Circuit
17 specifically addressed this issue :

18 The [district court] opinion says anticipation may be
19 shown by less than "complete anticipation" if one of
20 ordinary skill may in reliance on the prior art "complete
21 the work required for the invention", and that "it is
22 sufficient for an anticipation 'if the general aspects are
23 the same and the differences in minor matters is only
24 such as would suggest itself to one of ordinary skill in the
25 art.' "Those statements relate to obviousness, not
26 anticipation. Anticipation requires the presence in a
27 single prior art disclosure of all elements of a claimed
28 invention arranged as in the claim. A prior art disclosure
29 that "almost" meets that standard may render the claim
30 invalid under §103; it does not "anticipate."

1 *Connell. v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198
2 (Fed. Cir. 1983) (citations omitted). .

3 The Examiner's finding that the subject matter of Claims 1 and 5 are
4 anticipated is reversed.

5 Since the rejections of the remaining claims all rely on Tokarz as
6 describing the "more fragile" limitation, we reverse the rejection of Claims
7 2-4 and 6-11 also.

8 **NEW GROUND OF REJECTION**

9 We enter a new ground of rejection of Claim 1. Claim 1 is rejected
10 under 35 U.S.C. § 103(a) over Tokarz. Tokarz describes a handle assembly
11 as part of a faucet including a shank (base **20**) and handle (lever or handle
12 body **22**).¹⁶ The handle **22** may be made of a material including "metal such
13 as chrome or brass, wood, porcelain or plastic."¹⁷ Tokarz is silent as to the
14 material of the shank or base portion **20**. However, the use of metals for the
15 base and other parts of the faucet is ubiquitous. One having ordinary skill in
16 the art would recognize, as noted by the Examiner, that the shank portion is
17 likely to be a metal such as chrome plated brass. It would have been
18 obvious to use the typical metal base with any of the handle materials
19 described by Tokarz, including porcelain and plastic. Porcelain and plastic
20 are materials more fragile than metal. Applicant's Claim 1 encompasses
21 subject matter (e.g., a faucet lever with a metal shank or base and a porcelain
22 or plastic handle) which would have been obvious to a person having
23 ordinary skill in the art from Tokarz's teachings.

¹⁶ Tokarz, Figure 1 and 2:32-48.

¹⁷ Tokarz 1:56-59.

1 Applicant argues that Claim 1 requires that the shank be attached to a
2 door.¹⁸ However, the claim has no such requirement. Claim 1 specifies a
3 lever “for a door” and that the shank is “to be attached” to a door. These
4 statements merely describe the context of the lever assembly and do not
5 impart any essential structure to the claimed combination of handle and
6 shank. Language that merely states the purpose or intended use of an
7 invention is generally not treated as limiting the scope of the claim.
8 *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d
9 1339, 1345, 65 USPQ2d 1961, 1964-65 (Fed. Cir. 2003). The combination
10 of a shank and handle as set forth in the claim describes a structurally
11 complete invention.

12 Applicant also argues that the function of the lever assembly (the
13 combination of a shank and handle) to be attached to a door is different than
14 the function of Tokarz’s lever assembly as part of a faucet.¹⁹ Applicant
15 further argues that the intended use limitations require a distinct structure
16 necessary to attach the lever assembly to a door.²⁰ However, the “functions”
17 merely reflect the intended use of the shank and handle combination and add
18 nothing to the required structure. Nor does the statement of intended use
19 import undefined additional structure into the claim. The only required
20 structure relates to the shank and handle.

21 We express no view as to the patentability of Claims 2-11 which we
22 leave to the further consideration of the Examiner in light of the new ground
23 of rejection.

¹⁸ Appeal Br. 4; Reply Br., 1.

¹⁹ Appeal Br. 4.

²⁰ Reply Br. 1.

ORDER

The rejections of Claims 1-11 are reversed.

Claim 1 is unpatentable over Tokarz under 35 U.S.C. 103(a).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). That section provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED AND NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b)

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